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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,451	12/22/2000	Xiaodong Wang	UTSD:546USDI	4000

7590 08/27/2002

Gina N. Shishima, Esq.  
FULBRIGHT & JAWORSKI  
600 Congress Avenue, Suite 1900  
Austin, TX 78701

EXAMINER

MOORE, WILLIAM W

ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application N .</b>	<b>Applicant(s)</b>	
	09/748,451	WANG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	William W. Moore	1652	
<b>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</b>			
<b>Period for Reply</b>			
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.			
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>			
<b>Status</b>			
<p>1)<input type="checkbox"/> Responsive to communication(s) filed on ____ .</p> <p>2a)<input type="checkbox"/> This action is <b>FINAL</b>.                  2b)<input type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>			
<b>Disposition of Claims</b>			
<p>4)<input checked="" type="checkbox"/> Claim(s) <u>91 and 94-124</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) ____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) ____ is/are allowed.</p> <p>6)<input type="checkbox"/> Claim(s) ____ is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) ____ is/are objected to.</p> <p>8)<input checked="" type="checkbox"/> Claim(s) <u>91 and 94-124</u> are subject to restriction and/or election requirement.</p>			
<b>Application Papers</b>			
<p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on ____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p>Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p>			
<p>11)<input type="checkbox"/> The proposed drawing correction filed on ____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved by the Examiner.</p> <p>If approved, corrected drawings are required in reply to this Office action.</p>			
<p>12)<input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>			
<b>Priority under 35 U.S.C. §§ 119 and 120</b>			
<p>13)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p>1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p>2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. ____ .</p> <p>3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p>* See the attached detailed Office action for a list of the certified copies not received.</p>			
<p>14)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).</p> <p>a)<input type="checkbox"/> The translation of the foreign language provisional application has been received.</p>			
<p>15)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>			
<b>Attachment(s)</b>			
<p>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ .</p>		<p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) ____ .</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____</p>	

## DETAILED ACTION

### *Preliminary Amendments*

Applicant's Preliminary Amendment A, Paper No. 8 filed with the application on December 22, 2000, has been entered, canceling the original claims 1-90, 92 and 93, 5 and adding twenty-four new claims which were renumbered consecutively after the highest numbered original claim remaining in the application, claim 100, as claims 101-124 pursuant to 37 CFR 1.126.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- 10 I. Claims 91 and 101-110, drawn to a DNA fragmentation factor complex for regulating chromatin stability comprising a DFF40 polypeptide and a DFF45 polypeptide, classified in class 530, subclass 350.
- II. Claims 94-99, drawn, if properly stated, to a recombinant method of making a DNA fragmentation factor complex, classified in class 435, subclass 69.1.
- 15 III. Claim 100, drawn to a method of making a complex comprising an altered DFF45 DNA fragmentation factor, classified in class 435, subclass 471.
- IV. Claims 111-116, drawn, if properly stated, to a nucleic acid sequence encoding a human DFF40 DNA fragmentation factor or fragments thereof, classified in class 536, subclass 23.1.
- 20 V. Claims 117-119, drawn to a nucleic acid sequence encoding a fusion polypeptide comprising a DFF40 DNA fragmentation factor and a heterologous polypeptide, classified in class 536, subclass 23.4.
- VI. Claims 120-124, drawn to an isolated peptide fragment of a human DFF40 DNA fragmentation factor, classified in class 530, subclass 300.

25 Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process.

30 Inventions of Group I and Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP §

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808.01). In the instant case the different inventions are not disclosed as capable of use together and, as claimed, must have different modes of operation and effects.

Inventions of Group I and Groups IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation and different functions and effects.

Inventions of Group I and Group VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination has the capacity to conduct DNA fragmentation. The subcombination has separate utility such as the preparation of antibodies that need not recognize the combination.

Inventions of Group II and Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and, as claimed, must have different functions and effects.

Inventions of Group IV and Group II are related, in part, as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group IV, which may be fragmentary as claimed, can be used in a materially different process of use such as recombinant production of immunogenic fragments of the DFF40 fragmentation factor.

Inventions of Group II and Groups V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable

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of use together and, as claimed, must have different modes of operation and different functions and effects.

Inventions of Group III and Groups IV, V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they 5 have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and, as claimed, must have different modes of operation and different functions and effects.

Inventions of Group IV and Groups V and VI are unrelated. Inventions are unrelated 10 if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and, as claimed, must have different modes of operation and different functions and effects.

Inventions of Group V and Group VI are unrelated. Inventions are unrelated if it can 15 be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and, as claimed, must have different modes of operation and different functions 20 and effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms. Gina N. Shishima on August 22, 2002, to request 25 an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### Conclusion

Any inquiry concerning this communication or earlier communications from the 30 examiner should be directed to William W. Moore whose telephone number is 703.308.0583. The examiner can normally be reached between 7:00AM-5:30PM EST on Mondays and Wednesdays, between 7:00AM-1:30PM EST on Tuesdays and Thursdays, and between 8:30AM and 5:00PM EST on Fridays. The examiner's direct FAX telephone number is 703.746.3169. If attempts to reach the examiner by 35

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telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached at 703.308.3804. Further fax phone numbers for the organization where this application or proceeding is assigned are 703.308.4242 for regular communications and 703.308.0294 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0196.

5  
10      William W. Moore  
          August 22, 2002

  
PONNATHAPURA MURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600